

Amendment and Response

Applicant: Michael D. Hamerski et al.

Serial No.: 10/749,580

Filed: December 31, 2003

Docket No.: M120.224.101 / 59116US002

Title: METHOD OF APPLYING A FORCE TO A WORK PIECE

REMARKS

The following remarks are made in response to the Non-Final Office Action mailed November 14, 2005. In that Office Action, claims 1-6 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Bergman, PCT Publication No. WO 87/01324 ("Bergman") in view of Schumann, U.S. Patent No. 5,921,514 ("Schumann"). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergman in view of Schumann, and further in view of Meichtry, U.S. Patent No. 6,874,347 ("Meichtry"). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergman in view of Schumann, and further in view of Ritter, U.S. Patent No. 6,792,790 ("Ritter"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergman in view of Schumann, and further in view of Holsapple, U.S. Patent No. 3,712,106 ("Holsapple"). Claims 11-15, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ventura, U.S. Patent No. 6,722,179 ("Ventura") in view of Bergman, and further in view of Schumann. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ventura in view of Bergman and Schumann, and further in view of Meichtry. Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ventura in view of Bergman and Schumann, and further in view of Ritter.

With this Response, claim 21 is newly presented, and claims 1, 2, 11, and 19 have been amended. Claims 1-21 remain pending in the application and are presented for consideration and allowance.

35 U.S.C. § 103 Rejections

Regarding independent claims 1, 11, and 19, claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergman in view of Schumann, and claims 11-15, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ventura in view of Bergman and further in view of Schumann.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify or combine the reference teachings. Second, there must exist a reasonable expectation of success. Third, the references must teach or suggest all of the claim limitations. MPEP § 2143.

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Bergman teaches a device for securing an overlap adhesive joint (Title). The Bergman device is intended for use in joining vehicle body panel parts, and in particular, in fastening economy panel parts to an automobile. With regard to Figure 1, Bergman teaches at page 6, line 18 to page 7, line 27 that the device includes a bridge element 11 and an attachment plate 13 connected to the bridge element 11 via connection means 15 and 17. As best illustrated in Figure 1, means 15 is a threaded rod projecting at a right angle relative to the bridge element 11, and a wing nut 17 is threaded onto the rod such that together they form means for connecting the attachment plate 13 and bridge element 11. The bridge element 11 is a straight beam having end elements 21 and 22 welded to opposing ends of the bridge element 11. The attachment plate 13 is a flat disk and includes a double sided adhesive tape 29 adhered to a panel part 1 or panel part 2.

Schumann teaches a redetachable self-adhesive hook (Title). With references to Figures 1 and 2, Schumann teaches that the hook 1 is bonded to a tile 6. The hook includes a square base plate 2 to which is bonded a strip 4 of adhesive film. In this regard, Schumann teaches at column 4, lines 11-20 that strips 4 measuring 15 mm by 15 mm are punched out by a lift punch, and adhered to the base plate 2 that measures 20 mm square. Schumann teaches at column 4, lines 21-24 that in order to detach the hook 1, the base plate 2 is firmly grasped on both faces and rotated clockwise in the plane of the bond. As a result, the adhesive film 4 separates from the tile 6 without leaving any residue or causing damage. Alternately, Schumann teaches at column 4, lines 25-30 that separation of the base plate 2 from the tile 6 can be affected by engaging a key having an appropriately shaped pin into a groove 21 in the base plate 2. The key is employed to transfer a torque to separate the hook 1 from the tile 6.

It is conceded at page 2 of the Office Action mailed November 14, 2005 that Bergman does not disclose a stretch releasable tape. The Office Action takes the position that Schumann teaches a double-sided stretch adhesive tape, and it would have been obvious to one skilled in the art to provide the adhesive tape of Bergman with the stretch releasability as taught by Schumann in rendering claims 1-6 obvious. Applicant respectfully traverses the rejections as follows.

With this Response, independent claim 1 has been amended to provide a method of applying a compressive force to a selected location on a work piece, including attaching a body

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member to a surface using a first double-sided stretch releasable adhesive strip, where one end of a force applying member is attached to the surface using a second double-sided stretch releasable adhesive strip adjacent the selected location.

Notably, Bergman fails to teach or suggest at least the limitation of attaching a body member to a surface using a first double-sided stretch releasable adhesive strip and attaching a force applying member to the surface with a second double-sided stretch releasable strip. The Examiner has analogized the plate 13 of Bergman as being a “body member” and the bridge element ends 21, 23 of Bergman as being a “force applying member”. Bergman clearly teaches that while the plate 13 is attached to the surface, the bridge element ends 21, 23 are not attached to the surface, let alone attached by a stretch release strip. Thus, regardless of how the plate 13 and bridge element ends 21, 23 are characterized, modifying Bergman in view of Schumann results only in the plate 13 being attached by a double-sided stretch release strip. The bridge ends 21, 23 are not attached by any strip. It is respectfully submitted that Bergman in view of Schumann does not teach or suggest attaching a body member to a surface using a first double-sided stretch releasable adhesive strip, where one end of a force applying member is attached to the surface using a second double-sided stretch releasable adhesive strip, as required by amended independent claim 1.

Claims 11-15, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ventura in view of Bergman and further in view of Schumann. The Examiner concedes at page 4 of the Office Action mailed November 14, 2005 that Ventura (a hot melt adhesive) in view of Bergman does not disclose a stretch releasable tape. The Examiner takes the position that Schumann teaches a double-sided stretch adhesive tape such that it would have been obvious to one skilled in the art to provide the adhesive tape of Ventura in view of Bergman with the stretch releaseability as taught by Schumann in order to render the claims obvious. Applicant respectfully traverses the rejections to claims 11-15, 19, and 20 as follows.

First, it is respectfully submitted that a *prima facie* case of obviousness cannot be established based upon the cited references as there is no suggestion or motivation to modify or combine the reference teachings. For example, Ventura teaches a dent puller having a plate 19 glued to a panel 3 with a hot melt adhesive. In this regard, the Ventura device necessitates a

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strong and aggressive adhesive bond. In contrast, the adhesive tape taught in Schumann merely adheres a hook device to a wall. Pointedly, Schumann describes the adhesive film as supporting weights up to half a kilogram. (Schumann, col. 4, ll. 18-19). Although Ventura does not teach a specific bond strength, it is reasonable to conclude that a bond strength well in excess of 0.5 Kg is required to pull a dent from a metal automotive body panel. Thus, it is respectfully submitted that, if combined with Ventura, the adhesive tape of Schumann would lack sufficient adhesive bond strength between the plate 19 and the panel 3 (Ventura) to enable dent removal, and thus not satisfy the intended purpose of Ventura. For at least this reason, it is respectfully submitted that there is no suggestion or motivation to modify or combine the cited reference teachings.

In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. Moreover, even if the cited references were to be combined, the purported combination fails to teach or suggest all of the claimed limitations, as more fully described below.

With this Response, independent claim 11 has been amended to provide a method of applying a tensile force to a selected location on a work piece comprising attaching a body member to a surface using a first double-sided stretch releasable adhesive strip, where one end of a force applying member is adjacent the selected location, and attaching the force applying member to the surface using an additional double-sided stretch releasable adhesive strip.

The Examiner has analogized the engagement member 7/plate 19 as being a "body member," and the shaft 9/nut 10 as being a "force applying member." It is respectfully submitted that the shaft 9 cannot be a "force applying member" as set forth in claim 11, as claim 11 recites that the force applying member is moveably connected with the body member; because the shaft 9 does not move relative to the engagement member 7/plate 19 (or "body member"), it cannot be the "force applying member" of claim 11. Further, claim 11 requires that the force applying member be attached to the surface. The nut 10 is not attached to the surface, so it also cannot be the "force applying member" of claim 11. In addition, Ventura teaches adhering only the plate 19 (of the engagement member 7) to the panel 3 with a hot melt adhesive. Thus, for example, the feet 17 of Ventura are not adhered to the surface. Even if the teaching of

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Ventura were to be combined with the strip of Bergman and the adhesive tape of Schumann, the resulting device still only adheres the plate 19 to the panel 3. Thus, it is respectfully submitted that Ventura in view of Bergman and further in view of Schumann does not teach or suggest attaching a body member to a surface using a first double-sided stretch releasable adhesive strip, and attaching a force applying member to a surface using an additional stretch releasable adhesive strip, as required by amended independent claim 11.

With this Response, independent claim 19 has been amended to provide a method of removing a dent from a surface including arranging a device on the surface such that a body member is attached to the surface with a first double-sided stretch releasable adhesive strip and one end of a force applying member is adjacent the dent, and attaching the force applying member to the dented surface using a separate double-sided stretch releasable adhesive strip.

For the reasons set forth above, it is respectfully submitted that even if the references are combined as proposed, Ventura in view of Bergman and further in view of Schumann will result in a device that merely adheres the plate 19 to the panel 3. In contrast, amended independent claim 19 requires a body member attached to a surface with a first double-sided stretch releasable adhesive strip, and attaching a force applying member to the dented surface using a separate double-sided stretch releasable adhesive strip. Thus, it is respectfully submitted that Ventura in view of Bergman and further in view of Schumann fails to teach or suggest at least these limitations of amended independent claim 19.

Claims 2-10 further define patentably distinct amended independent claim 1; claims 12-18 further define patentably distinct amended independent claim 11; claim 20 further defines patentably distinct amended independent claim 19. It is respectfully submitted that amended independent claims 1, 11, and 19 are nonobvious under 35 U.S.C. § 103, such that all claims that depend from these independent claims must also therefore be nonobvious. MPEP § 2143.03.

It is respectfully requested that the rejections to claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Bergman in view of Schumann be withdrawn. In addition, it is respectfully requested that the rejections to claims 11-15, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Ventura in view of Bergman and further in view of Schumann be withdrawn. Based on this, Applicant respectfully requests that claims 1-20 be allowed.

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With this Response, claim 21 is newly presented to particularly point out and distinctly claim subject matter that the Applicant regards as inventive. In this regard, newly presented claim 21 provides a method as defined in claim 1, wherein attaching the body member to the surface includes positioning the first double-sided stretch releasable adhesive strip such that a non-adhesive pull tab of the strip extends laterally beyond the body member. None of the cited references provide for a non-adhesive pull tab of the adhesive strip extending laterally beyond the body member, as required by newly presented claim 21. In addition, it is noted that Schumann teaches away from this limitation at column 2, lines 7-9 where Schumann teaches that for releasable hooks utility is restricted wherein some cases it is not possible to have a grip tab freely accessible at all; and at column 2, lines 60-65 where Schumann teaches that with his device the adhesive tape no longer requires any grip tab at all. Based upon this, it is respectfully submitted that claim 21 recites additional patentably distinct subject matter.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-21 recite patentable subject matter, are in form for allowance, and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-21 is respectfully requested.

Applicants hereby authorize the Commissioner for Patents to charge Deposit Account No. 50-0471 in the amount of \$50 to cover the fees for claims in excess of 20 as set forth under 37 C.F.R. 1.16(i).

The Examiner is invited to telephone the Applicant's representative at the below-listed numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed either David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833; or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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3M INNOVATIVE PROPERTIES COMPANY

P.O. Box 33427

St. Paul, MN 55133-3427

Respectfully submitted,

Michael D. Hamerski et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC

Fifth Street Towers, Suite 2250

100 South Fifth Street

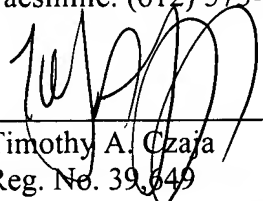
Minneapolis, MN 55402

Telephone: (612) 573-2004

Facsimile: (612) 573-2005

Date: FEBRUARY 17, 2006

TAC: imv



Timothy A. Czaja
Reg. No. 39,649

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17th day of February, 2006

By: 

Name: Timothy A. Czaja